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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,405	05/08/2000	PAIVI HUOVINEN	365-442P	9154
2292	7590	11/18/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			RABAGO, ROBERTO	
			ART UNIT	PAPER NUMBER
			1713	20

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,405

Applicant(s)

HUOVINEN ET AL.

Examiner

Rob Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/21/03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-34 and 41 is/are allowed.
- 6) ☒ Claim(s) 8-17, 20-30, 35 and 38-40 is/are rejected.
- 7) ☐ Claim(s) 36 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/2003 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13, 15, 16, 20, 27, 35 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Each of claims 13, 16, 35 and 38 recite two pairs of values for the same polymer properties(i.e., each of MFR2 for the high and low molar mass polymer) and therefore the intended scope of the claim cannot be determined.

(b) Claims 15 and 16 include two different descriptions for each of R and R', and therefore the intended scope of the claims cannot be determined.

(c) Process claim 20 has been amended to depend from non-elected product claim 1 and therefore the intended scope of the claim cannot be determined.

(d) The clean version of amended claim 27 does not agree with the marked-up version, and therefore the intended scope of the claim cannot be determined because it cannot be determined which version contains the error. As written in the "clean" version, the claim is furthermore indefinite because it cannot be determined whether the condensate is recirculated to the first reactor or to a subsequent reactor.

Claim Rejections - 35 USC § 102 and/or 103

4. Claims 8-11, 17, 21-26, 28-30, 39 and 40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Andtsjo et al. (WO97/13790).

Examples 11-12 disclose a two-stage polymerization of propylene including a loop reactor as the first stage, followed by a gas phase reactor in the second polymerization stage. The first stage contains hydrogen for control of molecular weight, while the second stage contains little or no hydrogen (see also page 12, lines 21-23). The polymer from the loop reactor stage recites the required MFR_2 , and the MFR_2 of the overall polymer is substantially lower than that of the first stage. Although the MFR_2 for the second stage polymer has not been separately reported, the claimed value would be inherent because prior examples have shown that this same catalyst would make a polymer with the claimed MFR_2 when hydrogen is substantially or completely excluded (see Example 3). Accordingly, the cited examples include all claimed limitations, either

expressly or inherently. The burden of proof is shifted to applicants to show that the applied reference examples do not contain all claimed limitations. In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

In the event that any differences can be shown for the product specified in the claims as opposed to the product taught in the applied reference, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985). Specifically, the reference directs that hydrogen should be substantially or completely removed from the reaction mixture before feeding to the gas phase reactor, and this recommended step further ensures that the MFR₂ of the high molecular weight component would be lower than the maximum set forth in the instant claims.

Applicant's arguments filed 3/24/2003 have been addressed in the Advisory Action mailed 4/4/2003.

5. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andtsjo et al. (WO97/13790).

The parent claims have been discussed with respect to this reference above. The elements of claims 12 and 14 have been disclosed at page 10, line 26, and at page 11, lines 1-11, respectively. One of ordinary skill in the art would be motivated to use these alternative embodiments because they have been specifically recommended by the reference authors, with reasonable success expected.

Allowable Subject Matter

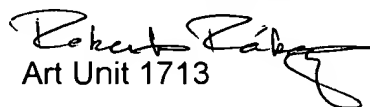
6. Claims 31-34, 41 are allowed. Claims 36 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rábago whose telephone number is (703) 308-4347. The examiner can normally be reached on Monday - Friday from 7:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

ROBERTO RABAGO
PATENT EXAMINER


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RR
November 17, 2003